

REMARKS

Claims 1-68 were previously pending in the instant application. Applicants respectfully request reconsideration of the instant application in the view of the preceding amendments and/or the following remarks. By way of the instant Amendment/Response, claim 68 has been amended to provide clarification, better track practical implementations, and/or to correct minor typographical informalities. Applicants submit that support for the amendments may be found throughout the originally filed specification, drawings and claims, and that no new matter has been added by way of this Amendment/Response. Applicants submit that the original claims are patentably distinct from the cited references and explicitly reserve the right to add/pursue the original claims at a later date and/or in one or more continuation and/or divisional applications. Claims 1-68 are currently pending.

Applicants thank the Examiner for the acknowledgement that independent claim 68 is patentably distinct from the applied references (March 31, 2009 Office Action, p. 65-68).

Claim Objections

Claim 64 has been objected to as allegedly containing particular informalities. Specifically, the pending rejection alleges, “The third line of claim 64 recites ‘receiving from at least one customer’,” and, “[t]he fourth line of claim 68 recites ‘from a requester.’” Applicants assume that the Examiner intends to refer only to claim 68, and not to claim 64, which recites neither “at least one customer” nor “a requester.” Should the Examiner maintain the objection with respect to claim 64, Applicants respectfully request further clarification as to which aspects of claim 64 the Examiner is objecting to. With reference to claim 68, Applicants have amended

the claim to remove “from a requester.” Accordingly, Applicants respectfully submit that the Examiner’s objection to the claim has been overcome.

The pending rejection also alleges, “on page 31 of the amended claims, ‘preferred load factor discrepancy’ should be ‘preferred itinerary load factor discrepancy’, and ‘alternate load factor discrepancy’ should be ‘alternate itinerary load factor discrepancy.’” Applicants have amended claim 68 to recite “preferred itinerary load factor discrepancy” and “alternate itinerary load factor discrepancy,” consistent with the antecedent usage. Accordingly, Applicants submit that the Examiner’s objection to the claim has been overcome.

Rejections under 35 U.S.C. § 101

Claims 68 has been rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Examiner has alleged that “Claim 68 is non-statutory since it may be performed without a particular machine, and largely within the human mind.” (March 31, 2009 Office Action, p. 4, ¶ 1). Although Applicants respectfully traverse this rejection and submit that the claims are clearly directed to statutory subject matter and that the pending rejection has not established a *prima facie* showing of non-statutory subject matter, Applicants have amended independent claim 68 to provide clarification and better track commercial implementations. Amended independent claim 68 recites, *inter alia*:

A travel product sale offering processor-implemented method for offering a travel product for sale, comprising:
 receiving via a communications network from at least one customer an electronic travel inquiry related to a transportation ticket ...
 ...
 querying from a tolerance database an acceptable travel date range and an acceptable travel time range;
 retrieving from a travel records database a plurality of alternative transportation ticket records based on the travel inquiry

wherein retrieving the plurality of alternative transportation ticket records further comprises:

- comparing by the processor an alternate origin associated with each of the plurality of alternative transportation ticket records to the preferred origin,
- comparing by the processor an alternate destination associated with each of the plurality of alternative transportation ticket records to the preferred destination,
- comparing by the processor an alternate travel date associated with each of the plurality of alternative transportation ticket records to the preferred travel date,
- comparing by the processor an alternate travel time associated with each of the plurality of alternative transportation ticket records to the preferred travel time, and
- retrieving by the processor only those alternative transportation ticket records having alternate origins matching the preferred origin, ...
- determining by the processor a preferred itinerary margin ...
- determining by the processor a preferred itinerary load factor discrepancy ...
- ...
- computing by the processor a projected load factor based on the current load factor and the historical sales data, and
- computing by the processor the itinerary load factor as the difference between the optimal load factor and the projected load factor;
- determining by the processor a value differential ...
- ...
- querying from a benefit rating database a benefit rating weighting schedule;
- computing by the processor a weighted benefit rating based on the weighting schedule, the date difference, the time difference, and the class difference;
- ...
- providing via the communications network at least one benefit and at least one alternative travel ticket record for review by the customer.

Applicants submit that amended independent claim 68 is clearly directed to statutory subject matter and, accordingly, respectfully request reconsideration and withdrawal of this basis of rejections. Furthermore, Applicants are unclear as to how the Examiner is alleging claim 68 could allegedly "be performed ... largely within the human mind," as alleged in the pending rejection. MPEP § 2106 (C) states that, "[w]hile abstract ideas, natural phenomena , and

laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be."

Applicants submit that the pending claims "perform a real-world function" and are clearly directed to statutory subject matter. Applicants further submit that components of the claim such as "determining by the processor a preferred itinerary margin for the travel inquiry," "determining by the processor a preferred itinerary load factor discrepancy for the travel inquiry," "computing by the processor a projected load factor," "computing by the processor the itinerary load factor," "determining by the processor a value differential," "computing by the processor a weighed benefit rating," and/or the like clearly do not constitute so-called "insignificant post-solution activity." Accordingly, should the Examiner maintain the rejection, Applicants respectfully request clarification as to how the Examiner believes components of claim 68, including "querying from a tolerance database an acceptable travel date range," "retrieving from a travel records database a plurality of alternative transportation ticket records," and "providing via the communications network at least one benefit and at least one alternative travel ticket for review by the customer," constitute so-called "insignificant post-solution activity" or could possibly be performed "largely within the human mind," and why the Examiner believes the claim does not "perform a real-world function."

Applicants also submit that the pending rejection has not established a *prima facie* showing of non-statutory subject matter. MPEP § 2106 (IV) requires that the Examiner:

- (A) consider the breadth of 35 U.S.C. § 101 under the Controlling Law;
- (B) determine whether the claimed invention falls within an enumerated statutory category;
- (C) determine whether the claimed invention falls within 35 U.S.C. § 101 Judicial Exceptions - Laws of Nature, Natural Phenomena, and Abstract Ideas;

(1) determine whether the claimed invention covers either a 35 U.S.C. § 101 Judicial Exception or a practical application of a 35 U.S.C. § 101 Judicial Exception;

(2) determine whether the claimed invention is a practical application of an abstract idea, law of nature or natural phenomenon;

(i) practical application by physical transformation;

(ii) practical Application that produces a useful, concrete and tangible result; and

(3) determine whether the claimed invention preempts a 35 U.S.C. § 101 Judicial Exception (Abstract Idea, Law of Nature, or Natural Phenomenon).

Furthermore, MPEP § 2106 (IV)(D) prescribes that, "USPTO personnel should review the totality of the evidence (e.g., the specification, claims, relevant prior art) before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter," and that, "[i]f the record as a whole suggests that it is more likely than not that the claimed invention would be considered a practical application of an abstract idea, natural phenomenon, or law of nature, then USPTO personnel should not reject the claim." Applicants submit that the pending rejection has not undertaken each of the required steps to establish a *prima facie* showing of non-statutory subject matter, including a "review [of] the totality of the evidence." Instead, the pending rejection has merely categorically asserted that claim 68 is not "tied to a particular machine" and "does not recite transforming underlying subject matter to a different state or thing." (March 31, 2009 Office Action, p. 3, ¶ 4). Accordingly, Applicants submit that a *prima facie* showing of non-statutory subject matter has not been established and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request that all required steps for establishing a *prima facie* case of non-statutory subject matter be undertaken so that Applicants can better understand the Examiner's concerns and provide a more complete response at the earliest opportunity.

Applicants also note that MPEP § 706 (II) states that,

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

The Examiner has previously noted that claim 68 is patentable over the applied references. Accordingly, should the Examiner maintain the rejection with regard to independent claim 68, Applicants respectfully request, and would greatly appreciate, that the Examiner "offer a definite suggestion for correction," to alleviate any of his lingering concerns with regard to the claim and 35 U.S.C. § 101 in order to place the claim in condition for allowance.

Rejections under 35 U.S.C. § 112

Claims 1-67 have been rejected under 35 U.S.C. § 112 ¶ 1 as allegedly failing to comply with the written description requirement. Specifically, the Examiner has alleged, "The specification does not describe a data structure in this sense in such a way as to reasonably convey that the inventors, at the time the application was filed, had possession of the claimed invention." (March 31, 2009 Office Action, p 4., ¶ 3). Applicants respectfully traverse this rejection and submit that the claims clearly comply with the written description requirement and that the pending rejection has not established a *prima facie* showing of failure to comply with the written description requirement.

MPEP § 2163.04 states that, "A description as filed is presumed to be adequate unless or until sufficient evidence or reasoning to the contrary has been presented by the

examiner to rebut the presumption," and that, "[t]he examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." The MPEP proceeds to describe the evidentiary requirements for a showing of lack of sufficient written description:

- (A) Identify the claim limitations at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.... (MPEP § 2163.04)

The pending rejection alleges, "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention," that, "[t]he definition of a 'data structure' is 'a physical or logical relationship among data elements, designed to support specific data manipulation functions'," and that "[t]he specification does not describe a data structure in this sense in such a way as to reasonably convey that the inventors, at the time the application was filed, had possession of the claimed invention." (March 31, 2009 Office Action, p. 4, ¶ 3). Except for reciting a definition of the term "data structure" as found in The New IEEE Standard Dictionary of Electrical and Electronics Terms, the pending rejection has provided only conclusory allegations of a lack of written description, and has not provided any "reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed," as required by the MPEP. Applicants submit that the pending rejection, providing conclusory allegations in place of the required "reasons," is analogous to the "general allegation of 'unpredictability in the art'"

specifically noted in the MPEP as "not a sufficient reason to support a rejection for lack of adequate written description." Applicants further note that evidence of the inventors' possession of the invention may be found throughout the originally filed specification, drawings, and claims, including p. 11, line 17 to p. 12, line 6; p. 12 line 7 to p. 18, line 13; and p. 30 lines 1-8.

As the specification clearly evinces possession of the invention at the time of filing and the pending rejection has not put forth a "preponderance of evidence," including a *prima facie* showing of lack of adequate written description, Applicants submit that the presumption of adequate written description has not been overcome and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification, including a presentation "by a preponderance of evidence" that includes "reasons why a person skilled in the art ... would not have recognized that the inventor was in possession of the invention," (emphasis added) as required by the MPEP, so that Applicants may fully understand the Examiner's concern and provide a complete reply at the earliest opportunity.

Rejections under 35 U.S.C. § 103

Claims 1-67 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Katz, et al. (US Patent No. 6,055,513) ("Katz"); Tasker ("Should We Send Bad Guys' Guns to the Contras?") ("Tasker"); Walker et al. (US Patent No. 7,249,050) ("Walker"); Johnson ("Family Dollar on the Move"); Dinell ("Businesses Taking a Hard Look at Air Travel as Fares Increase" ("Dinell"); an anonymous article ("Western Pacific Load Factor

Reaches 55 Percent in September") ("Western Pacific"); De Lapa et al. (US Patent No. 5,822,735) ("De Lapa"); O'Brien, et al. (US Patent No. 5,832,457) ("O'Brien"); Popyk ("The Mastercard Approach to Customer Service") ("Popyk"); Webber, et al. (US Patent No. 5,331,546) ("Webber"); Brown, et al. (US Patent Application No. 2006/0206393) ("Brown"); Caldwell ("Hotels Pull a Switch") ("Caldwell"); Zaccarelli ("Is Your 'Internal Marketing' up to Par?") ("Zaccarelli"); and the Examiner's Official Notice. Applicants respectfully traverse this rejection and submit that a *prima facie* showing of obviousness has not been established and that the twelve applied references and official notice, taken individually or in combination, fail to discuss or render obvious every element of each pending claim.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that, by over-generalizing the applied references, the pending rejection has failed to establish at least either of the first two elements of a *prima facie* case of obviousness. Independent claim 1 recites, *inter alia*,

A computer-implemented method for offering a travel product for sale, comprising:

...
computing values to a seller associated with the preferred product record and the at least one alternate travel product record based on at least one travel product relation parameter;

selecting at last one alternate product based on the at least one received alternate travel product record, wherein the at least one alternate travel product ... is related to the preferred travel product by the at least one travel product relation parameter that is configured as an electronic data structure; and

...

Applicants submit that at least these elements from independent claim 1 are not discussed or rendered obvious by the applied references, taken alone or in combination. The pending rejection alleges, "Tasker further teaches that an alternate travel product being upsold is related to the preferred travel product by at least one travel product relation parameter (in that both are hotel rooms, and presumably covering the same period; "SUITENING THE POT" section)." (March 31, 2009 Office Action, p. 6, ¶ 1). The pending rejection goes on to allege that, "Neither Katz, Tasker, nor Walker expressly discloses that the at least one product relation parameter is configured as an electronic data structure, but official notice is taken that electronic data structures are well known." (March 31, 2009 Office Action, p. 7, ¶ 2). Thus, the pending rejection has apparently based its rejection of elements shown above in independent claim 1, including "the at least one travel product relation parameter that is configured as an electronic data structure," on a combination of official notice and the Examiner's admitted presumption of the existence of a travel product relation parameter in Tasker. Applicants submit that the reliance on the Examiner's presumption and "official notice" as two essential elements of the Examiner's obviousness rejection is inappropriate, and stretches the applied references well beyond their content. Applicants submit that the objectivity of the obviousness inquiry is compromised by first dissecting claim elements, and then drawing presumptions from the applied references and supplementing missing pieces with "official notice" to allegedly show the dissected pieces. Instead, Applicants submit that the rejection should be based on evidence explicitly present, or at least argued by the Examiner to be inherent, in the applied references. In

that regard, Applicants note that Tasker discusses psychology-based upselling using conversational sales techniques, and does not suggest or enable computer-implemented methods such as those described in the pending claims. Furthermore, there is no clear way, and the pending rejection has not indicated any, that the informal salesmanship techniques described in Tasker could be combined with the electronic systems described in the other applied references with which the pending rejection has attempted to combine it. Applicants submit that none of the applied references discuss or render obvious at least, "the at least one travel product relation parameter that is configured as an electronic data structure," as recited in independent claim 1, nor has the pending rejection indicated any objective evidence that the applied references discuss or render obvious this component of independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request that the Examiner either point to explicit evidence in the applied references as allegedly discussing or rendering obvious all of the claim elements, or at least provide an argument as to why he believes the claim elements are allegedly inherent in the applied references, so that Applicants can have an objective basis on which to reply to the Examiner's concerns at the earliest opportunity.

Applicants further note that the pending rejection has alleged, "Walker teaches computing values to a seller associated with a preferred product record and at least one alternate product record based on at least one product relation parameter (Abstract, column 3, line 42, through column 4, line 3; column 11, lines 14-39; column 15, lines 5-28; column 17, line 23-31)." (March 31, 2009 Office Action, p. 7, ¶ 1). However, in the same rejection, the Examiner refers to Tasker as allegedly discussing "a travel product relation parameter," as recited in independent claim 1, based on the Examiner's analogy between "a travel product relation

parameter" and the fact that the two hotel rooms in Tasker "both are hotel rooms, and presumably covering the same time period." (March 31, 2009 Office Action, p. 6, ¶ 1). Independent claim 1 recites, "the at least one alternate travel product ... is related to the preferred travel product by the at least one travel product relation parameter," and, "computing values to a seller ... based on at least one travel product relation parameter." Thus, the pending rejection has cited disparate elements from different references as allegedly discussing the same component recited in claim 1, thus failing to respect structural aspects of the claim as reflected by antecedent relationships of claim components. The Examiner has apparently alleged that, "both are hotel rooms, and presumably covering the same time period" from Tasker is analogous to the claimed "travel product relation parameter," but has not provided any indication or explanation as to how that parameter is used or could possibly be used in "computing values to a seller," as recited in claim 1. Applicants submit that the references as applied do not, in combination, yield or render obvious every element of independent claim 1 and that the pending rejection has failed to respect the antecedent structure reflected in the claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to how he believes, "both are hotel rooms, and presumably covering the same time period," is or could possibly be used for "computing values to a seller ... based on at least one travel product relation parameter," as recited in independent claim 1.

Applicants have also previously noted that the Examiner has improperly grouped multiple claim elements together for rejection under a single group of reference citations, instead of showing specific correspondences between claim components and citations from the applied references, in at least the August 1, 2008 and March 31, 2009 Office Actions (see February 2,

2009 Response, pp. 35-36). For example, Applicants have pointed to the following excerpt from the pending rejection:

As per claim 29, Katz discloses a computer-implemented method for offering a product for sale, comprising: receiving an inquiry indicative of a preferred product from a customer, and receiving at least one alternate product record from a database, wherein the at least one alternate product record is based upon the product inquiry, the alternate product record being indicative of an alternate product; selecting at least one alternate product, based on the at least one alternate product record; transmitting an offer to sell the selected product to a customer; and receiving an acceptance to purchase the at least one alternate product from the customer (Abstract; Figure 4; Figure 7; column 8, line 34, through column 9, line 21; column 11, line 62, through column 12, line 39; column 19, lines 24-58; column 23, line 40, through column 24, line 11; column 25, line 56, through column 26, line 3; column 26, lines 13-37). (March 31, 2009 Office Action, p. 18, ¶ 1)

In response to Applicants' prior request for clarification in the Examiner's rejection, including a showing of specific alleged correspondences between claim elements and citations from the applied references, the Examiner has stated in the March 31, 2009 Office Action that "the elements listed are found in the parts of the Katz patent listed, and there is no need to go into fine detail." (March 31, 2009 Office Action, p. 69, ¶ 1). As Applicants have previously noted, Applicants are unclear as to the specific correspondences alleged between the applied references and components of the pending claims, and are forced to guess at the Examiner's concerns regarding the applied references and to effectively formulate their own rejection. MPEP § 706 prescribes that, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Accordingly, Applicants submit that there is in fact a need for the Examiner to provide sufficient detail in his rejection to enable Applicants to provide a complete reply fully addressing the Examiner's concerns. Thus, should the Examiner maintain the rejection, Applicants respectfully

reiterate their request for a specific showing of alleged correspondence between claim elements and citations from the applied references so that prosecution of the instant application can advance without further, undue delay.

Furthermore, Applicants submit that the pending rejection has failed to properly set forth the differences in the claims over the applied references and to explain why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by proposing modifications to art that teaches away from such modifications and that would render the cited art unsuitable for its stated purpose, by failing to provide sufficient objective rationale for modifying the references, and by not providing a discussion of the level of ordinary skill in the art.

Applicants have previously argued that the applied references teach away from the combination proposed by the Examiner in the pending rejection (see February 2, 2009 Response, pp. 37-38). Specifically, Applicants have noted that Katz describes a "most particular[]" objective that "the product or service offered differs materially from the product or service for which contact was made," (Katz, col. 1, lines 1-16, emphasis added), and that this fundamentally contrasts with the "upselling" discussed in Tasker, wherein one very similar hotel room is substituted for another [the Examiner has even presumed in the pending rejection that the rooms are "covering the same time period" (March 31, 2009 Office Action, p. 6, ¶ 1)]. In response to Applicants' arguments that Katz teaches away from the proposed modifications, the Examiner has alleged that "Katz does not teach away from the requisite modification, because Katz does not teach that the upsold product or service is totally unlike the " (March 31, 2009 Office Action, p. 69, ¶ 1, emphasis added, original omission). Although Katz specifically states

that "the product or service offered differs materially from the product or service for which contact is made," the Examiner apparently believes that the difference is not material enough. The Examiner points, for example, to col. 9, lines 6-21 of Katz, which describes that the "new product ... includes the functionalities of the product which formed the basis for the primary transaction." However, the cited portion of Katz specifically describes the "product which formed the basis for the primary transaction" being "a service contract" (emphasis added) for "repair of a defective product," while the so-called "upsell" product is "a sales contract for a new product which includes the functionalities of the product which formed the basis of the primary transaction" (emphasis added). Effectively, Katz describes selling apples to an orange buyer, while Tasker describes selling tangerines to the orange buyer. Thus, Applicants submit that the original product (the service contract) and the upsell product (the sales contract) in Katz still "differ[] materially," even if the products underlying the two contracts may have functional similarities. Accordingly, Applicants maintain their argument that Katz teaches away from the proposed modifications, and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to why the Examiner believes that the products "differ[ing] materially" in Katz is insufficient and why he believes they must be "totally unlike" to support the argument that Katz teaches away from the proposed modifications. Furthermore, Applicants respectfully request clarification as to what the Examiner believes would constitute "totally unlike" products, and why he believes "a service contract" and "a sales contract" fail that standard.

Applicants have also previously submitted that the pending rejection has not put forth sufficient objective rationale to support the legal conclusion of obviousness (see February 2, 2009 Response, pp.38-39). Specifically, Applicants have noted that the Examiner has

concluded obviousness of the claims based on alleged obviousness of individual claim components in isolation instead of in relation to the claims as wholes. For example, the pending rejection alleges, "that the at least one alternate product provides a greater value to a seller if sold than the preferred product ... is considered obvious," "travel products are well known," "it would have been obvious to ... compute such values," "electronic data structures are well known," etc. (March 31, 2009 Office Action, pp. 6-7). Based on such allegations in the pending rejection, Applicants have previously submitted that the Examiner has only addressed obviousness of the differences in the claim over the applied references, and not of the claims as wholes, as required for example by MPEP § 2141.02 (I), which prescribes, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (original emphasis). In response to Applicants' arguments, the Examiner has referred to several legal standards related to obviousness, including that "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references," and that "the teaching, suggestion or motivation test should not be applied as a rigid and mandatory formula that limits obviousness analysis through a formalistic conception" (March 31, 2009 Office Action, p. 70, ¶ 1-2). However, Applicants are unclear as to how the Examiner believes these quoted standards relate to the issue of evaluating obviousness of claim elements in isolation instead of in relation to the claim as a whole, in contradistinction to the prescription of MPEP § 2141.02 (I). Applicants submit that, even under the quoted standards, the Examiner still cannot conclude obviousness of the claims based on an assertion of obviousness of individual claim components

in isolation (e.g., "it would have been obvious to ... compute such values"), but rather that the alleged obviousness of each claim component must be evaluated with reference to every other element of the claim (i.e., in relation to the claim as a whole). Accordingly, Applicants submit that a *prima facie* showing of obviousness has not been made, and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request that he either clarify how he believes the obviousness standards quoted in the pending rejection render the prescription of MPEP § 2141.02 (I) invalid and unnecessary, or that he evaluate obviousness of the claims as wholes by analyzing the alleged obviousness of claim components in relation to the other elements of the claim.

Applicants have also previously submitted that the pending rejection has failed to provide a discussion of the level of ordinary skill in the art at the time of the invention (see February 2, 2009 Response, pp. 39-40). As noted previously, MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." In response to Applicants' argument that the pending rejection has provided no indication of the level of ordinary skill, the Examiner has stated in the March 31, 2009 Office Action that,

Examiner maintains that the combination made would have been obvious to one of ordinary skill in the art; such a person plausibly would have been familiar with articles published by the time of Applicant's priority date, and, in the eyes of the law, with patent publications having valid priority. Nothing in Examiner's rejections is believed to attribute extraordinary skill or knowledge to the hypothetical person of ordinary skill in the art at the time of the invention. (March 31, 2009 Office Action, p. 69, ¶ 2 to p. 70, ¶ 1).

It is clear from the Examiner's reply that he believes that the pending rejection has not "attribute[d] extraordinary skill or knowledge to the hypothetical person of ordinary skill in the art at the time the invention was made," however Applicants submit that this is tautological

and provides no further insight or indication as to what level of skill the Examiner believes is allegedly attributable to "the hypothetical person of ordinary skill in the art at the time the invention was made." MPEP § 2141.03 (III) states that, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry" [quoting *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1991)]. Although the pending rejection has repeatedly alleged obviousness of aspects of the claims, no indication has been provided of the level of ordinary skill which those aspects would allegedly be obvious to. Accordingly, Applicants submit that "objectivity in the obviousness inquiry" has been compromised, and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully reiterate their request that the Examiner discuss the alleged level of ordinary skill in the art at the time the invention in order to preserve objectivity of the obviousness inquiry and provide Applicants with a clear and objective basis on which to provide a response.

Applicants further submit that none of the other cited references remedy the deficiencies identified above with respect to Katz and Tasker in relation to independent claim 1. Furthermore, although of different scope than independent claim 1, Applicants submit that independent claims 29, 33, 35, 39-51, 61-63, 67 and 68 are also are patentable over the cited references, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the cited references in relation to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection for these claims as well.

Applicants also note that the pending rejection has stated that "[i]f Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph [with respect to claims 39, 40, 41 and 42, reciting "means for" language], Applicant should provide an explicit statement to that effect." (March 31, 2009 Office Action, p. 68, ¶ 2). Applicants hereby expressly request that claims 39-42, which recite "means for" language, be examined in light of 35 U.S.C. § 112, ¶ 6.

Applicants also submit that claims 2-28, 30-32, 34, 36-38, 52-60 and 64-66, which are directly or indirectly dependent from independent claims 1, 29, 33, 35, 39-51, and 61-63, are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the cited references in relation to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection for these claims as well.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-68, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While

many other claim elements were not discussed, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized and requested to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-079US1. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-079US1.

Respectfully submitted,
CHADBOURNE & PARKE , L.L.P.

Dated: September 30, 2009

By: /Walter G. Hanchuk/
Walter G. Hanchuk
Registration No. 35,179

Correspondence Address:

CHADBOURNE & PARKE, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile